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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,088	05/19/2004	Marc Nazare	DEAV2003/0032 US NP	5676
5487	7590	05/10/2007		
ROSS J. OEHLER SANOFI-AVENTIS U.S. LLC 1041 ROUTE 202-206 MAIL CODE: D303A BRIDGEWATER, NJ 08807			EXAMINER SOLOLA, TAOFIQ A	
			ART UNIT 1625	PAPER NUMBER
			NOTIFICATION DATE 05/10/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/849,088

Applicant(s)

NAZARE ET AL.

Examiner

Taofiq A. Solola

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 17 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 11, 12 and 16-18 is/are rejected.
- 7) ☐ Claim(s) 1-10 and 13-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1</u> . | 6) <input type="checkbox"/> Other: _____ |

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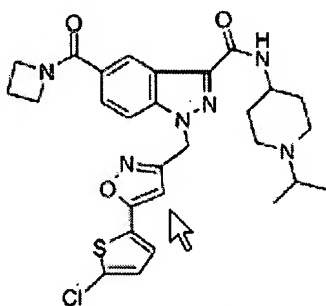
Claims 1-18 are pending in this application.

Claims 11-12, 14-18 are drawn to non-elected invention.

RESTRICTION REQUIREMENT

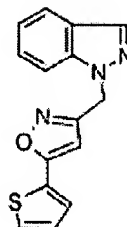
In response to the Restriction Requirement, Applicant elects with traverse the invention of group I, claims 1-10, 13. The traversal is on the basis that a search of the compound is a search of the process of making and use thereof. This is not persuasive because formula I, in and of itself is not searchable, and therefore is subject to restriction requirement. However, the restriction of the inventions of groups II and III is now withdrawn and claims 11-12, 14-18 are now rejoined with the elected invention.

In addition to the election of group I, Applicant also elects the following species:



wherein in formula I, J1 is N, J2

is N-Q-R°, R° is 5-(5-chloro-thiophen-2-yl)-isoxazol-3-yl, Q is methylene, D is phenyl substituted by R3, R1 is H, R2 and G are direct bonds, R3 is azetidin-1-carbonyl, V is piperadine, and M is isopropyl. Therefore, claims 1-18 are being examined in part subject to the election made by applicant.

Status of Claims

Applicant also submitted a central core, which has been searched and found novel. Therefore, all the substituents of the core within the scope of claim 1, would not be subject to further restriction. The following are now in condition for allowance over prior arts of record.

In formula I, J1 is N, J2 is N-Q-R^o, R^o is 5-(5-chloro-thiophen-2-yl)-isoxazol-3-yl, Q is methylene, D is phenyl substituted by R3. R1-R2, M, G, and V are as defined in claim 1. As a result of the election and the corresponding scope of the invention identified herein, the remaining subject matter of claims 1-18, are withdrawn from further consideration by the Examiner, under 37 CFR § 1.142(b), as being drawn to a non-elected subject matter. The withdrawn compounds are patentably distinct from the examined invention as they differ in structure and element and would require a separate search. In addition, a reference, which anticipates the examined invention, would not render obvious the non-examined subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the

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relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 16-17 are not drawn to practical utilities and claim 18 lacks adequate support in the specification. One must read the specification into claims 16-17 contrary to precedent court decisions and Office practice. There is no conclusive evidence in the specification that are thrombosis is involve in all the diseases listed in claim 18, and they are not known as such. By deleting claims 16-17 and limit 18 to using the compounds as antithrombic agents the rejection would be overcome.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 11-12, 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For reasons set forth above under 35 USC 112, first paragraph, claims 16-18 are indefinite.

The term "derivatives", line 26, claim 11, and phraseology "functional groups can also be present that are subsequently transformed into final functional groups present in . . ." and similar phraseologies in every occurrence in claims 11-12 render the claims indefinite. The derivatives and/or functional groups are not defined in the claims or the specification so as to ascertain the metes and bounds of the claims. Also, the phraseologies are not within the scope of allowable compounds of claim 1. The phrase "can be", claim 11, line 25, and in every occurrence in claims 11-12 renders the claims indefinite and must be deleted.

Priority document

The foreign priority document in application 10/728,339 is EP 03011307.0, 5/19/03, not 03011303.9.

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Objected

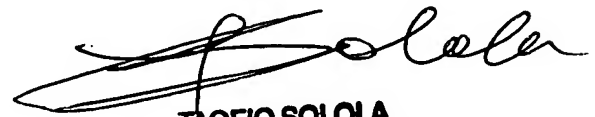
Claims 1-10, 13-15, are objected to for containing non-elected subject matter. To place the claims in condition for allowance, the claims must be amended within the scope of allowable subject matter set forth above under Status of Claims.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Thomas McKenzie, can be reached on (571) 272-0670. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.



**TAOFIQ SOLOLA
PRIMARY EXAMINER**

Group 1625

May 1, 2007